REMARKS

Claims 1 through 7 and 9 through 16 are pending in this application, of which claims 3, 4, and 9 through 13 were indicated allowable if presented in independent form. Claims 1 and 10 have been amended for grammar and claim 16 has been added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the original filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 2 and 7 were rejected under 35 U.S.C. §103 for obviousness predicated upon JP 09-002832 (J'832) in view of JP6-199536 (J'536).

The Examiner's rejection is predicated upon the conclusion that one having ordinary skill in the art would have been motivated to modify the methodology of J'832 by enhancing an asserted temperature lowering step by including the cooling means disclosed by J'536. This rejection is traversed as factually and legally erroneous.

Insufficient Facts

The Examiner's rejection is based upon the inaccurate factual determination that the methodology of J'832 comprises a temperature lowing step. Because of this inaccurate factual interpretation of J'832, the Examiner concluded that one having ordinary skill in the art would have been motivated to employ any type of cooling, including the means disclosed by J'536, regardless of the context in which it is used. But the stubborn fact is that J'832 does **not,** repeat **not,** disclose a

temperature lowing step as asserted by the Examiner. Just the opposite -- J'832 seeks to prevent a decrease in temperature.

Subsequent to the issuance of the April 8, 2003 Office Action the Examiner provided English language translations of J'536 and J'832. Applicants submit herewith, as Exhibit A, an English language translation of paragraphs [0021] to [0028] of J'832. This English language translation is not inconsistent with that provided by the Examiner.

It should be apparent from the attached translation, and from the translations provided by the Examiner, that when the atmospheric temperature in the upper end portion of an upper chamber decreases, the chamber is **heated** (not cooled) by employing a heat preserving heater in accordance with the teachings of J'832. In addition, J'832 discloses that on/off control to energize the heat preserving heater is implemented so that the temperature of the upper edge portion is kept within in a predetermined temperature range.

It is **not** apparent and the Examiner has **not** pointed out wherein J'283 discloses (or even desires) decreasing the temperature in the upper change, i.e., that cooling is positively performed. Applicants would note that in accordance with the teachings of J'283, when the drawing of the optical fiber preform is executed and, as a result, the length of the left preform becomes shorter, the temperature in the upper end of the upper chamber becomes **undesirably lower**.

It should, therefore, be apparent that the heat preserving heater employed in J'832 is employed to overcome an undesirable cooling. Manifestly, J'832 does not seek to preform a temperature lowing step. Accordingly, there is no temperature lowing step to be enhanced as asserted by the Examiner.

There is no Motivation

In order to establish the requisite motivation, the Examiner must point to a **source** in the applied prior art for **each** claim limitation and a **source** in the applied prior art for the requisite **motivational** element. *Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).* More to the point, the Examiner is required to make a "thorough and searching" factual inquiry and, based upon that factual inquiry and, based upon that factual inquiry, explain **why** one having ordinary skill in the art would been realistically impelled to modify particular prior art, in this case the **particular** method disclosed by J'832, to arrive at the claimed invention. *In re Lee, 237 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).* Such a factual inquiry requires clear and particular factual findings as to a specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify the **particular** method disclosed by J'832 to arrive at the claimed invention. *Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); Ecolochem Inc. v. Southern California Edison, Co. 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Kotzab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).* Merely identifying wherein features of a claimed invention are perceived to reside in disparate references does not establish the requisite motivation. *In re Kotzab, supra; Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).* Rather, a **specific reason** must be offered based upon **facts** to support the asserted motivation--not generalizations. *Ecolochem Inc. v. Southern California Edison, Co. supra; In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).*

In applying the above legal tenets to the exigencies of this case, Applicants submit that the requisite motivation element has **not** been established. Specifically, the Examiner asserted that one having ordinary skill in the art would have been motivated to enhance a temperature lowing step in J'832. As previously pointed out, J'832 seeks to maintain a temperature and discloses that cooling is undesirable. Accordingly, for starters, the Examiner's proposed modification of the methodology of J'832 is **inconsistent** with the disclosed objectives. It is well settled that one having ordinary skill in the art can **not** be presumed motivated to modify a reference in a manner **inconsistent** with the disclosed objective. *In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); In re Schulpen, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).*

Further, the mere fact that J'536 discloses cooling means does not mean one having ordinary skill in the art would have been automatically motivated to impress that particular cooling means in the particular methodology of J'832, leaving aside the fact that J'832 does not want cooling. Specifically, the cooling method disclosed by J'536 does **not** relate to cooling an upper chamber during drawing of an optical preform. The Examiner's assertion that the combined disclosures teach the claimed invention is inconsistent with recent decisions by the Court of Appeals for the Federal Circuit requiring the Examiner to make clear and particular factual findings as to a specific understanding of specific technological principle which would have realistically impelled one having ordinary skill in the art to get to the combined disclosures in the first place . *Ruiz v. A.B. Chance Co., supra; Ecolochem Inc. v. Southern California Edison, Co., supra; In re Kotzab, supra; In re Dembiczak, supra.* The Examiner can not sit by and ignore the fact that J'536 does not relate to cooling the upper chamber during drawing of an optical fiber. The reason the Examiner can not ignore this is that if the cooling technique of J'536 is performed during drawing of the optical fiber

preform, cooling gas flows peripherally to the optical fiber preformed as it is drawn **because** the upper chamber and the drawing furnace communicate with each other. This would necessarily cause a variation in the outer diameter of the optical fiber which is antithetic to the disclosed objective.

It should, therefore be apparent that a prima facie basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Applicants, therefore, submit that the imposed rejection of claims 1, 2 and 7 under 35 U.S.C. §103 for obviousness predicated upon J'832 in view of J'536 is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 5, 6, 14 and 15 were rejected under 35 U.S.C. §103 for obviousness predicated upon J'832 in view of J'536 and Kubo et al.

This rejection is traversed. Specifically, claims 5 and 6 depend from independent claim 1 while claims 14 and 15 depend from independent claim 7. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 7 under 35 U.S.C. §103 for obviousness predicated upon J'832 in view of J'536. The additional reference to Kubo et al. does not remedy the argued shortcomings in the attempted combination of J'832 and J'536.

Applicants, therefore, submit that the imposed rejection of claims 5, 6, 14 and 15 under 35 U.S.C. §103 for obviousness predicate upon J'832 in view of J'536 is not factually or legally viable and, hence, solicit withdrawal thereof.

New claim 16

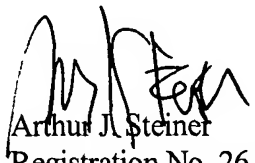
New claim 16 is free of the applied prior art for reason which should be apparent from the argument previously advanced in traversing the imposed rejection of claims 1 and 7. The applied prior art does not disclose or suggest the concept of cooling an upper portion of the preform during fiber drawing, let alone by cooling provided out of the preform container.

Applicants acknowledge, with appreciation, the Examiner's indication that claims 3 through 5 and 9 through 13 contain allowable subject matter. Based upon the arguments submitted supra, it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



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